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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/577,976	04/02/2007	Flemming Kjaergaard Christensen	PATRADE	7548
7590	06/11/2009			
James C. Wray 1493 Chain Bridge Road Suite 300 McLean, VA 22101			EXAMINER MI, QIUWEN	
			ART UNIT 1655	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/577,976	CHRISTENSEN, FLEMMING KJAERGAARD	
	Examiner	Art Unit	
	QIUWEN MI	1655	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 April 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) 6 and 8-10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7, 11 and 12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicant's amendment in the reply filed on 4/27/09 is acknowledged, with the additional newly added Claim 12. Claims 1-12 are pending. Claims 6, and 8-10 are withdrawn from further consideration as being drawn to nonelected inventions and species. **Claims 1-5, 7, 11, and 12 are examined on the merits.**

Any rejection that is not reiterated is hereby withdrawn.

Claim Rejections –35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5, 7, and 11 remain rejected, and claim 12 is newly rejected under 35 U.S.C. 103(a) as being unpatentable over Yamashita (JP 06128121 A), in view of Aizawa et al (JP 58079912 A) and Tomono et al (JP 11279069 A), and further in view of Hasegawa et al (JP 2001302525 A), and Larsen et al (US 2005/0113293).

This rejection is maintained for reasons of record set forth in the Office Action mailed out on 11/25/2008, repeated below. Applicants' arguments filed have been fully considered but they are not deemed to be persuasive.

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Yamashita teaches a cosmetic containing, as the active component, an extract of *Aspalathus linearis* excellent in removal of active oxygen and moisture retention and exhibiting a high safety to the skin (see Abstract, the rejection is based on the Abstract, full translation is attached).

Yamashita does not teach the incorporation of the extract of deep-sea fish, extract of *Arctostaphylos uva-ursi*, or diacetyl boldine into the composition.

Aizawa et al teach a cosmetic having high safety, excellent feeling and physical properties and low oiliness, and giving refreshing, moist and smooth feeling to the skin, by compounding an oil derived from a deep-sea fish (see Abstract, the rejection is based on the Abstract, full translation is attached).

Tomono et al teach active oxygen eliminating agent or skin beautifying cosmetic composition comprises one or more kinds of plant extracts selected from among extracts of plant parts of *Arctostaphylos uva-ursi* (L). Spreng., etc. The agent has excellent active oxygen eliminating action and further can improve a roughened skin and impart gloss and tenseness to the skin (see Abstract, the rejection is based on the Abstract, full translation is attached).

Hasegawa et al teach skin external preparation for use in cosmetics and pharmaceuticals, and for whitening of skin, comprises extract of specified plants e.g. *Equisetum arvense* (see Title). The skin external preparation has improved skin whitening effect, and is excellent in stability and safety. The skin external preparation efficiently prevents dark complexion, stain and freckle (see Abstract, the rejection is based on the Abstract, full translation of the document has been ordered).

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Larsen et al teach the use of a lipid extract of *Skeletonema costatum* which contains the alkaloid boldine in a cosmetic composition for the amelioration of the signs of skin ageing. Said lipid extract and the compound boldine improves the gap junctional intercellular communication in keratinocytes, fibroblasts and pre-adipocytes. The inventors show that treatment with boldine increases the content of connexin 43 in keratinocytes of middle aged and elderly people to the content found in keratinocytes of young people in a dose dependent manner with a boldine concentration of 50 nM being optimal. Since an increase of the cellular content of connexin 43 must contribute to a facilitation of gap junctional intercellular communication the compound boldine can be useful in the present invention [0743].

It would have been *prima facie* obvious for one of ordinary skill in the art at the time the invention was made to use the deep sea fish oil (thus an extract) from Aizawa et al since Aizawa et al teach it is having high safety, excellent feeling and physical properties and low oiliness, and giving refreshing, moist and smooth feeling to the skin.

It would also have been *prima facie* obvious for one of ordinary skill in the art at the time the invention was made to use extracts of plant parts of *Arctostaphylos uva-ursi* from Tomono et al since Tomono et al teach it has excellent active oxygen eliminating action and further can improve a roughened skin and impart gloss and tenseness to the skin.

It would also have been *prima facie* obvious for one of ordinary skill in the art at the time the invention was made to use extracts of *Equisetum arvense* from Hasegawa et al since Hasegawa et al teach it has improved skin whitening effect, and is excellent in stability and safety, prevents dark complexion, stain and freckle.

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It would also have been *prima facie* obvious for one of ordinary skill in the art at the time the invention was made to use boldine from Larsen et al since Larsen et al teach it ameliorates the signs of skin ageing.

Since all the compositions yielded beneficial results in cosmetic industry, one of ordinary skill in the art would have been motivated to make the modifications and combine the inventions together. Regarding the limitation to the use of boldine derivative, diacetyl boldine, the result-effective adjustment in conventional working parameters is deemed merely a matter of judicious selection and routine optimization which is well within the purview of the skilled artisan.

From the teachings of the references, it is apparent that one of the ordinary skills in the art would have had a reasonable expectation of success in producing the claimed invention.

Thus, the invention as a whole is *prima facie* obvious over the references, especially in the absence of evidence to the contrary.

Applicant argues that “Applicant traverses the art rejection based on the abstracts of each of the four Japanese references with a statement 'translations have been ordered' for each reference indicating that the body of each reference has more than what the abstract states, particularly that there is a possibility that each of those references teach away from a combination with the others. Applicant requests that the Examiner provide the translations of the complete references for each of the cited Japanese publications, so that Applicant can adequately rebut the rejections. See, for example, MPEP 707.059(a)” (page 4, 2nd paragraph from the bottom).

This is not found persuasive. As indicated in the previous Office Action, the rejection is based on abstract, now full translations are attached.

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Applicant argues that “The Examiner relies on each of the references of Yamashita, Aizawa, Tomono, Hasegawa and Larsen as teaching individual components of the claimed invention without providing any basis whatsoever as to where in each reference there is a motivation to combine the five teachings and arrive at the present invention” (page 4, last paragraph bridging page 5). Applicant further argues that “The Examiner's rejections are all based on precisely an "obvious to try" holding which has been repeatedly reversed by the Courts. A statement that modifications of the prior art to meet the claimed invention would have been "well within the ordinary skill of the art at the time the claimed invention was made" because the references relied upon teach that all aspects of the claimed invention were individually known in the art (emphasis supplied) is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). ***>[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR*, 550 U.S. at ___, 82 USPQ2d at 1396 quoting *In re Kahn*, 441 F.3d 977, 9gg, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)” (page 5, 2nd paragraph).

This is not found persuasive. The motivation to combine the references is stated explicitly above. It would have been *prima facie* obvious for one of ordinary skill in the art at the time the invention was made to use the deep sea fish oil (thus an extract) from Aizawa et al since Aizawa et al teach it is having high safety, excellent feeling and physical properties and low oiliness, and giving refreshing, moist and smooth feeling to the skin. It would also have been *prima facie* obvious for one of ordinary skill in the art at the time the invention was made to use

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extracts of plant parts of *Arctostaphylos uva-ursi* from Tomono et al since Tomono et al teach it has excellent active oxygen eliminating action and further can improve a roughened skin and impart gloss and tenseness to the skin. It would also have been *prima facie* obvious for one of ordinary skill in the art at the time the invention was made to use extracts of *Equisetum arvense* from Hasegawa et al since Hasegawa et al teach it has improved skin whitening effect, and is excellent in stability and safety, prevents dark complexion, stain and freckle. It would also have been *prima facie* obvious for one of ordinary skill in the art at the time the invention was made to use boldine from Larsen et al since Larsen et al teach it ameliorates the signs of skin ageing.

Applicant argues that “The Examiner does not provide any reasoning for why one of ordinary skill in the art would be motivated to use both Yamashita and Tomono when both are being relied on as teaching the elimination of active oxygen. Nothing in the abstracts of each of those references teaches or suggests a combination of the two. In fact, they teach away from combining because they teach an either/or alternative with the same results arrived at with either *apalathus linearis* or *Arctostaphylos uva-ursi*. Hasegawa mandates glycosyl-L-ascorbic acid with a combination of one or more other of 19 plant extracts. Thus, if the Examiner relies on Hasegawa for *Equisetum arvense*, there is no showing where in the reference there is a teaching or suggestion to use any of the plant extracts without the ascorbic acid required by Hasegawa. Larsen has been relied on as teaching alkaloid boldine. Larsen uses the alkaloid boldine with other compounds for treating different ailments in middle aged and elderly people. The claimed diacetyl boldine works via α -adrenergic antagonist receptors and calcium flow regulation and is not described, taught or suggested by Larsen” (page 5, last paragraph bridging page 6). Applicant further argues that “Moreover, nothing in any of the references teach or suggest a combination as

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effected by the Examiner. The mere fact that references can be combined or modified does not render the resultant combination obvious unless **>the results would have been predictable to one of ordinary skill in the art. *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 USPQ2d 1385, 1396 (2007)” (page 6, 2nd paragraph).

This is not found persuasive. First of all, for reference Hasegawa, since the instant claims use open language “comprising”, it does not preclude using any other components other than the claimed ones. For reference Larsen, in response to applicant's argument that the reference fails to disclose diaethyl boldine works via α -adrenergic antagonist receptors and calcium flow regulation, it is noted that the features upon which applicant relies are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Secondly, all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known composition, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of invention. In addition, KSR forecloses the argument that a specific teaching, suggestion, or motivation is required to support a finding of obviousness. See the recent Board decision *Ex parte Smith*, -- USPQ2d--, slip op. at 20 (Bd. Pat. App. & Interf. June 25, 2007) (citing KSR, 82 USPQ2d at 1396) (available at <http://www.uspto.gov/web/offices/dcom/bpai/prec/fd071925.pdf>).

Applicant argues that “Furthermore, it is respectfully submitted that the Examiner has not produced a *prima facie* case of obviousness for at least Claims 2-5, 7, and 11 for the additional reason that the limitations of those claims have not been addressed. It should not be left to the Applicant to attempt to reason how the rejection of claim 1 might apply to the dependent claims

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as it would be based on assumptions and conjecture” (page 6, 2nd paragraph). Applicant argues that “If examination at the initial stage does not produce a prima facie case of unpatentability, then without more the applicant is entitled to grant of the patent. *In re Oetiker*, 25 USPQ2d 1443, 1447 (Fed. Cir. 1992) citing *In re Grabiak*, 226 USPQ 870, 873 (Fed. Cir. 1985). The office action does not provide any basis for the rejection of each of the features in at least Claims 10 and 30 and therefore applicant is unable to determine Examiner's basis for the rejection of each of the claims to adequately rebut the rejections. Therefore, as dictated by *Oetiker* "without more applicant is entitled to grant of the patent." (page 6, 2nd paragraph from the bottom).

This is not found persuasive. The cited references have met all the claim limitations. Applicant's arguments have been fully considered but they are not persuasive, and therefore the rejections in the record are maintained.

Conclusion

No claim is allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Qiuwen Mi whose telephone number is 571-272-5984. The examiner can normally be reached on 8 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terry McKelvey can be reached on 571-272-0775. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

QM

/Michele Flood/

Primary Examiner, Art Unit 1655